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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,934	12/31/2001	Keith Bussell	47661/SAH/S850	3791

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EXAMINER

HINZE, LEO T

ART UNIT PAPER NUMBER

2854

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/040,934

Applicant(s)

BUSSELL, KEITH

Examiner

Leo T. Hinze

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/21/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. et al. in view of Nuggehalli et al.

Ryan teaches:

- a method of printing postal indicia (IBIP, col. 1, line 13) on an envelope, including printing a sample envelope (step 330) (claim 1).

Ryan does not teach:

- determining size of said envelope; selecting a height of said envelope; selecting a width of said envelope (claim 1);
- assigning said envelope a custom name (claim 3).

Nuggehalli teaches a printer and paper tray having a user programmable paper size, including:

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- determining size of said paper; selecting a height of said paper; selecting a width of said paper ( e.g. col. 3, lines 27-29, Fig. 10) (claim 1);
- assigning said custom paper size a custom name (e.g. col. 7, lines 24-25) (claim 3).

Regarding claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ryan to select the height and width of said envelope, because Nuggehalli teaches that the ability to use custom paper sizes provides increased flexibility of uses for a printer.

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ryan to assign a custom name to a custom paper size, because Nuggehalli teaches that the ability to use custom paper sizes provides increased flexibility of uses for a printer.

3. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. et al. in view of Nuggehalli et al., as applied to claims 1 and 3 above, and further in view of DeBarber et al.

The combination of Ryan and Nuggehalli teaches all that is claimed in the above rejections of claims 1 and 3, including printing said postal indicia onto said envelope (Ryan, step 365) (claim 4).

The combination of Ryan and Nuggehalli does not teach verifying the size of said envelope by placing on a template.

DeBarber teaches a machine for manipulating envelopes, including verifying the size of an envelope using a template (52, col. 3, lines 28-34) (claim 2).

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Regarding claim 2, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Ryan to use a template to verify the size of said envelope, because DeBarber teaches that this is effective at eliminating trial and error in determining if envelopes are too large or too small.

Regarding claim 4, the combination of Ryan, Nuggehalli, and DeBarber teaches all that is claimed as discussed above.

4. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan, Jr. et al. in view of Nuggehalli et al. and DeBarber et al., as applied to claims 2 and 4 above, and further in view of Czernik et al.

The combination of Ryan, Nuggehalli, and DeBarber teaches all that is claimed as discussed in the above rejections of claim 4, including verifying (Ryan, steps 335, 340, and 345) the correct placement of the indicia on the envelope (claim 7).

The combination of Ryan, Nuggehalli, and DeBarber does not teach:

- said postal indicia including an FIM (claim 5);
- printing the FIM within a predefined distance of an edge of said envelope (claim 6).

Czernik teaches:

- said postal indicia including an FIM (e.g. col. 6, lines 2-3) (claim 5);
- printing the FIM within a predefined distance of an edge of said envelope (e.g. col. 3, lines 34-37) (claim 6).

Regarding claim 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Ryan to include an FIM in the postal indicia,

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because Czernik teaches that an FIM mark is useful for indicating that mail is suitable for automated processing.

Regarding claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Ryan to print the FIM within a predefined distance of an edge of said envelope because Czernik teaches that postal regulations require precise positioning of the FIM mark.

Regarding claim 7, the combination of Ryan, Nuggehalli, DeBarber, and Czernik teaches all that is claimed, as discussed above.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (703) 305-3339. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0952.

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*Leo T. Hinze*

Leo T. Hinze  
Patent Examiner  
AU 2854  
March 7, 2003

*Stephen R. Funk*

STEPHEN R. FUNK  
PRIMARY EXAMINER